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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/498,293      | 02/04/2000  | Ronald Roscoe Bush   | AT9-97-308B         | 8618             |

7590 06/10/2002

FELSMAN, BRADLEY, VADEN,  
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201 MAIN STREET  
SUITE 1600  
FORT WORTH, TX 76102

EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/498,293

Applicant(s)

BUSH, RONALD ROSCOE

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-20 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 18-20 and 31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 15-17, drawn to a method of processing electronic checks, classified in class 705, subclass 64.
- II. Claim 18-19,20 and 31, are drawn to a method of securing transmission of a global transponder location, classified in class 357.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a method of securing transmission of a global transponder location, as stated in invention II has no dependency on a method of processing electronic checks as stated in invention I. The subcombination has separate utility such as processing electronic checks.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Alan Kamrath on May 29, 2002 a provisional election was made with traverse to prosecute invention I, claims 15-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-19,20,31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 15-17 have been examined

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US Patent 5,848,400) and further in view of Arnold et al (US Patent 4,558,176).

As per claim 15

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Chang ('400) discloses a method of processing an electronic check, comprising:  
receiving an electronic check at a business; transmitting a first copy of said electronic check to a payor's bank and a second copy of said electronic check to a payee's bank;  
decoding said first copy of said electronic check at said payor's bank. (Abstract, Figure1)  
Chang does not explicitly disclose "encrypted using a one-time pad", Arnold et al discloses "encrypted using a one-time pad", (column 24, lines 24-32). It would be obvious to one of ordinary skill in the art at the time of the invention to utilize a one-time pad because this prevents adversaries from cracking codes that are reused.

As per claim 16,  
Chang ('400) discloses the method of claim 15, further comprising:  
authenticating said electronic check;  
transmitting said first copy of said electronic check to a clearinghouse with a payment authorization. (Figure 2)

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US Patent 5,848,400) and further in view of Official Notice.

As per claim 17,  
Chang ('400) discloses the method of claim 17, further comprising:  
transmitting said second copy of said electronic check to said clearinghouse; (column 7, lines 25-29)

Official notice is taken that it is old and well known in the art of check processing to compare said first copy of said electronic check to said second copy of said electronic check; and responsive to determining that said first copy of said electronic check matches said second copy of said electronic check, processing a transaction transferring funds from said payor's bank to said payee's bank. It would be obvious to one having ordinary skill in the art at the time of the invention to verify that duplicate copies of the issued check match to avoid forgeries

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Josephson et al. (US Patent 5,532,464)
- Stephens et al. (US Patent 5,237,159)
- Moseley. (US Patent 5,193,114)
- Carlson et al. (US Patent 5,053,607)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammel can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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May 30, 2002

  
JAMES P. TRAMMEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600